

## REMARKS

Applicants hereby submit the claims as pending during the prosecution of the parent application as of Applicants' first response filed July 8, 2002. However, claims 45 and 49 have been canceled and new claims 48-78 have been added. Accordingly, claims 14-78 are pending in the present application.

Claims 14-20 were rejected under 35 U.S.C. §102(b) or in the alternative under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,355,519 to Hasegawa and U.S. Patent No. 4,075,632 to Baldwin in the Office Action dated April 8, 2002 (the Office Action). Claims 35-47 were rejected under 35 U.S.C. §103(a) for obviousness over Hasegawa and Baldwin.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to claim 14, such claims was rejected over Hasegawa and Baldwin in the Office Action. It is stated on page 3 of the Action that an infinitely variable phase shifter would increase the accuracy in the simulation and subsequent transmission of a radio signal. Even if true, such fails to support an obviousness rejection of claim 14. Hasegawa is concerned with varying the phase in a *simulation system*. Baldwin is only concerned with fixed 90 degree phase shifts and in no fair interpretation is concerned with varying magnitude of phase shift or the use of a variable phase shifter. In fact, Baldwin expressly teaches away from such a combination. Applicant refers the Examiner to the teachings in col. 4, lines 28-34 of Baldwin wherein it is stated that the phase shifter must provide a 90 degree phase difference between the local oscillator inputs to the

mixers or a 90 degree phase difference between the receiver inputs to the mixers. There is absolutely no motivation to increase the complexity of Baldwin using a variable phase shifter when Baldwin expressly requires the use of a fixed phase shift angle providing a net 90 degree phase difference.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.).

There is absolutely no motivation to combine the reference teachings. To the contrary, the references expressly teach away from the combination. The only motivation can result from impermissible use of Applicants' teachings contrary to well-established precedent. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant also incorporates the previous arguments of the first Office Action response regarding the combination of Hasegawa and Baldwin. Baldwin already provides phase shifting in a transponder interrogation system. Accordingly, one of ordinary skill in the art would not look for further teachings regarding variable

phase shifting in Hasegawa to provide fixed phase shifting in a interrogation system inasmuch as Baldwin already provides such teachings. One of skill in the art would not look for additional phase shifter teachings of Hasegawa inasmuch as Baldwin provides phase shifting operations as identified in the Office Action. There is no motivation to increase the complexity of Baldwin with variable phase shift teachings when Baldwin calls for the use of a fixed phase shift.

Non-analogous art areas cannot properly be combined for an obviousness rejection where the problems addressed by each are non-analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986.) A field of art is analogous only if one seeking the solution in one art area would be likely to seek the solution by referring to the other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 USPQ 634 (Fed. Cir. 1985).

The teachings of the Baldwin patent have been improperly combined with the teachings of the Hasegawa patent to establish the obviousness rejection. Hasegawa is clearly concerned with simulation systems while Baldwin is directed towards interrogation systems. One of skill in the art of interrogation systems and concerned with problems of interrogation systems would not look to the irrelevant fading simulation of Hasegawa for meaningful teachings. In particular, the combination of non-analogous art areas is precluded by long standing Federal Circuit precedent. Prior art references are only analogous if the reference is in the field of Applicant's endeavor or the reference is reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01 (8th ed.) (citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir.

1992)). The 103 rejection of claim 14 is improper for at least these numerous reasons and Applicants request allowance of claim 14 in the next Action.

The claims which depend from independent claim 14 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants now address the rejections of the dependent claims set forth in the final Office Action dated November 25, 2002 of the parent. It was stated on page 3 of the Action that claims 42-44 and 46-48 were rejected for obviousness with absolutely no identification of reference teachings which allegedly disclose limitations of Applicants' claims. Further, the references, even if combined, fail to disclose positively-recited limitations of the dependent claims.

For example, claim 42 recites a phase adjuster configured to *adaptively select a phase shift angle responsive to the modulated radio frequency continuous wave signal*. Hasegawa teaches phase control means 14 which provides control independent of a radio frequency continuous wave signal. Col. 8, lines 42-45 of Hasegawa merely disclose control means 14 comprises storage means in which desired phase control data is stored. The control data is not responsive to a modulated RF CW signal as claimed. Baldwin discloses a fixed phase shift with no selection of a phase shift angle, let alone, selection of a phase shift angle responsive to a modulated RF CW signal as claimed. Claim 42 recites limitations not shown nor suggested in the prior art and claim 42 is allowable.

Claim 43 recites searching a plurality of different phase shift angles to

select the phase shift angle. The prior art references are devoid of disclosing any searching or selection as claimed. The Office Action fails to identify any teachings which allegedly disclose or suggest such limitations and claim 43 is allowable. Claim 43 is allowable.

Referring to claim 35, there is no motivation to combine the references and the 103 rejection of claim 35 is improper for at least this reason.

The claims which depend from independent claim 35 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a

non-final Action if any claims are not found to be allowable.

Support for the new claims is provided at least in the originally filed specification at pages 23-36 and Figs. 7 and 14.


New formal drawings are submitted herewith in accordance with the continuation application filing hereof and are the same drawings of the parent application.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 8/1/03

By:   
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